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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/676,382	09/30/2003	Corinne Bortolin	16222U-016700US	9159
66945 7590 11/17/2008 TOWNSEND AND TOWNSEND CREW LLP TWO EMBARCADERO CENTER, 8TH FLOOR SAN FRANCISCO, CA 94111				
EXAMINER				
LASTRA, DANIEL				
ART UNIT		PAPER NUMBER		
3688				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/676,382

Applicant(s)

BORTOLIN ET AL.

Examiner

DANIEL LASTRA

Art Unit

3688

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

1. Claims 1-20 have been examined. Application 10/676,382 (SYSTEM AND APPARATUS FOR LINKING MULTIPLE REWARDS PROGRAMS TO PROMOTE THE PURCHASE OF SPECIFIC PRODUCT MIXES) has a filing date 09/30/2003.

Response to Amendment

2. In response to Non Final Rejection filed 03/31/2008, the Applicant filed an Amendment on 07/25/2008, which amended claims 7, 16 and added new claims 19 and 20.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. With respect to claims 1-9 and 19, based on Supreme Court precedent, a method/process claim must (1) be tied to another statutory class of invention (such as a particular apparatus) (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)). A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject

matter. Here the claims fail to meet the above requirements because the steps are neither tied to another statutory class of invention (such as a particular apparatus). Claims 10-18 and 20 are defined as a computer readable medium, however, said claims only are claiming non functional descriptive material (i.e. data) as a "code" is not presented in the claims as computer-executable. Claim 19 is defined as computer readable medium claim however, said claim is dependent of a method claim.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2, 7 and 10-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 2, 7, 11 and 16 are indefinite because nowhere in Applicant's specification is explained the limitation "reducing or eliminating the combination reward, if a third product is purchased". For purpose of art rejection, said limitation is interpreted as not given a combination reward if the products in said combination reward are not purchased. With respect to claims 7 and 16, Applicant's specification paragraph 68 recites that a consumer participating in all programs allowed said consumer to access a special program (see paragraph 68). Therefore, the limitation "wherein the combination reward is the ability to access the combination reward or another reward at an earlier date *than dates associated with the first and second rewards*" is interpreted in light of Applicant's specification as simply allowing a

consumer that participate in a specific number of programs to access a special program earlier than other consumer that have not participated in said specific number of programs. Claims 10-20 are indefinite because they are not computer readable medium claims.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 8, 9, 10, 17 and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Vulkan (US 2003/0212626).

Claims 1 and 10, Vulkan teaches:

A method comprising:

(a) receiving information about a first pre-existing reward program for a first product, wherein the first reward program provides for a first reward (see paragraph 17);

(b) receiving information about a second pre-existing reward program for a second product, wherein the second reward program provides a second reward (see paragraph 17) ; and

(c) providing for a combination reward program that provides a combination reward that is based on at least the purchase of the first product and the second product, and wherein the combination reward is greater than each of the first reward and the second reward (see paragraph 17).

Claims 8 and 17, Vulkan teaches:

providing the combination reward to a customer (see paragraph 17).

Claims 9 and 18, Vulkan teaches:

wherein the first reward program is created by a first merchant and wherein the second reward program is created by a second merchant (see paragraph 92), and

wherein the combination reward program is created by a host organization that is affiliated with the first merchant and the second merchant (see paragraph 92).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-6 and 11-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vulkan (US 2003/0212626).

Claims 2 and 11, Vulkan does not expressly teach:

(d) reducing or eliminating the combination reward, if a third product is purchased. However, Official Notice is taken that it is old and well know in the promotion art that that if the products in a package deal are not purchased, said package deal is not honor. It would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Vulkan would honor a package deal if the products in said package deal are not purchased, as it is old and well know to do so.

Claims 3 and 12, Vulkan does not expressly teach:

receiving information about a third pre-existing reward program for a third product, wherein the third reward program provides a third reward, wherein the combination reward is greater than the third reward. However, it would have been obvious to a person ordinary skill in the art at the time the application was made, to know that Vulkan's system would allow the plurality of retailers participating in his system to increase their individual offers (i.e. third product) by teaming up with one another and offering combination rewards in order to increase the likelihood of impulse shopping (see paragraph 25).

Claims 4 and 13, Vulkan does not expressly teach:

wherein the combination reward program is provided by a host organization, and wherein the host organization also provides a portable consumer device, wherein the combination reward is provided to the consumer after the user uses the portable

consumer device, and wherein (a), (b), and (c) are performed using one or more digital computers. However, Official Notice is taken that it is old and well known in the promotion art to use portable consumer devices at point of sale terminal in order to redeem promotions. Therefore, it would have been obvious to a person ordinary skill in the art at the time the application was made, to know that Vulkan would use portable consumer devices in his promotion system as it is old and well known to do so.

Claims 5 and 14, Vulkan does not expressly teach:

wherein the combination reward program is provided by a host organization, and wherein the host organization also provides a portable consumer device, wherein the portable consumer device is a smart card. However, Official Notice is taken that it is old and well known in the promotion art to use smart cards in point of sale terminals in order to redeem promotions. Therefore, it would have been obvious to a person ordinary skill in the art at the time the application was made, to know that Vulkan would use smart cards in point of sale terminal in order to redeem promotions as it is old and well known to do so.

7. Claims 6 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vulkan (US 2003/0212626) in view of Ryan (US 2005/0055272).

Claims 6 and 15, Vulkan does not expressly teach:

wherein the combination reward is an extension of time to receive at least one of the first reward and the second reward. However, Ryan teaches that it is old and well known in the promotion art to extend the expiration date of a reward (i.e. cash value coupon) when said reward is offered in combination with another reward (i.e. joint a

private club as a reward) (see paragraph 52). Therefore, it would have been obvious to a person ordinary skill in the art at the time the application was made, to know that Vulkan would offer coupon rewards with an extension of time, when said coupon rewards are offered with a combination of another product, as Ryan teaches that it is old and well known to do so.

8. Claims 7, 16, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vulkan (US 2003/0212626) in view of Gauthier (US 2004/0148224).

Claims 7 and 16, Vulkan does not expressly teach:

wherein the combination reward is the ability to access the combination reward or another reward at an earlier date *than dates associated with the first and second rewards*. However, Gauthier teaches that it is old and well known in the promotion art to have incentive programs rules that allow a user that participate in a specific number of programs, such as using a card a number of times in a month or purchasing products from different vendors within a specified time frame to have earlier access to a higher prize than other users that take more time to fulfill said program's rules (see paragraphs 71-73). Therefore, it would have been obvious to a person ordinary skill in the art at the time the application was made, to know that Vulkan would allow users that purchase a specific number of products within a time frame to access bigger prizes at an earlier date than other users that fulfill said purchasing at a later date, as taught by Gauthier in order to provide said users an incentive to participate in a joint promotion program.

Claims 19 and 20, Vulkan does not teach:

Wherein the first product is purchased at a first location and the second product is purchased at a second location. However, Gauthier teaches that it is old and well known in the promotion art to have a joint promotion where the purchase of different products in different location using a portable card triggers prizes (see paragraph 73). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Vulkan's participating retailers would participate in a joint promotion which would provide an incentive for consumers to visit the participating retailers stores, as Gauthier teaches that it is old and well known to do.

Response to Arguments

9. Applicant's arguments filed 07/25/2008 have been fully considered but they are not persuasive. The Applicant argues that Vulkan does not disclose a system that receives information about a first pre-existing promotion and a second pre-existence promotion. The Examiner answers that Vulkan teaches that sellers team-up with one another to increase their offering of new products to be promoted, surplus, slow moving stock (see paragraph 25). Therefore, contrary to Applicant's argument, Vulkan in bundling pricing increases the offering of previous offering of individual items, and therefore, contrary to Applicant's argument, Vulkan teaches Applicant's claimed invention.

The Applicant argues that Vulkan does not teach that a cross promotion provide a reward greater than a first and a second rewards. The Examiner answers that Vulkan teaches that sellers increase their offering by teaming-up with one another, where Vulkan bundles' offers add value to buyers (see paragraphs 17, 25-27 "Buy A & B and

Pay X"). Therefore, contrary to Applicant's argument, Vulkan teaches Applicant's claimed invention.

The Applicant argues that Vulkan does not teach "reducing or eliminating the combination reward, if a third product is purchased". The Examiner answers that nowhere in Applicant's specification said limitation is explained.

The Applicant argues that Vulkan does not teach "wherein the combination reward is the ability to access the combination reward or another reward at an earlier date". The Examiner answers that Gauthier teaches that it is old and well known in the promotion art to have incentive programs rules that allow a user that participate in a specific number of programs, such as using a card a number of times in a month or purchasing products from different vendors within a specified time frame to have earlier access to a higher prize than other users that take more time to fulfill said program's rules (see paragraphs 71-73). Therefore, it would have been obvious to a person ordinary skill in the art at the time the application was made, to know that Vulkan would allow users that purchase a specific number of products within a time frame to access bigger prizes at an earlier date than other users that fulfill said purchasing at a later date, as taught by Gauthier in order to provide said users an incentive to participate in a joint promotion program.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James W. Myhre can be reached on (571)272-6722. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/DANIEL LASTRA/
Examiner, Art Unit 3688
November 7, 2008